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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,341	11/27/2001	Cecily Anne Snyder	020313-001810US	1973
20350	7590	01/18/2006	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			MEINECKE DIAZ, SUSANNA M	
			ART UNIT	PAPER NUMBER
			3623	

DATE MAILED: 01/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/996,341

Applicant(s)

SNYDER, CECILY ANNE

Examiner

Susanna M. Diaz

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ✓ 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ✓ 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/31/4/29/2/17.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Claims 1-20 are presented for examination.

#### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 2, and 4-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Kamarei et al. (U.S. Patent No. 6,859,806).

Kamarei discloses a computer-implemented method of generating a message for a first intellectual property case, the method comprising:

[Claim 1] storing information related to a plurality of intellectual property cases on a computer-readable medium, the plurality of intellectual property cases including the first intellectual property case (col. 5, lines 19-31 – Docketed cases are related to cases filed with a governmental office, such as a patent or trademark office; col. 6, line 49 – Case Listing Database; col. 10, lines 6-10 – Cases can be searched for and retrieved from a Case Listing Database, which implies that there are a plurality of cases stored);

receiving a signal indicating occurrence of an event related to the first intellectual property case (col. 8, line 45 through col. 9, line 2; col. 9, line 32 through col. 10, line 9);

responsive to receiving the signal, identifying one or more rules associated with the event (col. 8, line 45 through col. 9, line 2; col. 9, line 32 through col. 10, line 9);

identifying at least a first rule from the one or more rules based upon filter criteria information associated with the one or more rules and based upon information related to the first intellectual property case stored on the computer-readable medium (col. 8, line 45 through col. 9, line 2; col. 9, line 32 through col. 10, line 9);

generating at least one message using the at least first rule, the message identifying an action to be performed in response to the event and identifying a date associated with the action (col. 8, line 45 through col. 9, line 2; col. 9, line 32 through col. 10, line 9); and

communicating the at least one message to a first designated client system (col. 9, line 64 through col. 10, line 2);

[Claim 2] wherein the plurality of intellectual property cases includes patent cases and the first intellectual property case is a patent application case (col. 9, lines 6-10 – The case may be related to patent prosecution);

[Claim 4] wherein storing information related to the plurality of intellectual property cases on the computer-readable medium comprises:

for each intellectual property case, storing the information related to the intellectual property case in a case data unit, wherein the case data unit stores data related to the intellectual property case and one or more documents related to the intellectual property case (Fig. 6; col. 8, line 45 through col. 9, line 2; col. 9, line 32 through col. 10, line 9);

[Claim 5] wherein the signal indicating occurrence of the event related to the first intellectual property case is generated responsive to a change in the information related to the first intellectual property case (col. 12, lines 1-34);

[Claim 6] wherein identifying the at least first rule from the one or more rules based upon the filter criteria information comprises:

determining a set of rules from the one or more rules associated with the event, wherein a rule from the one or more rules is included in the set of rules if the filter criteria associated with the rule is satisfied by the information related to the first intellectual property case, the set of rules including the at least first rule (col. 8, line 45 through col. 9, line 2; col. 9, line 32 through col. 10, line 9);

[Claim 7] wherein the plurality of intellectual property cases includes patent cases and the first intellectual property case is a patent application case; and

the filter criteria associated with each rule in the one or more rules comprises a criterion related to filing status of a patent case, a criterion related to a type of the patent case, and a criterion related to priority information for a patent case (Fig. 6; col. 8, line 45 through col. 9, line 2; col. 9, line 32 through col. 10, line 9);

[Claim 8] wherein generating the at least one message using the at least first rule comprises:

determining an action associated with the at least first rule (col. 8, line 45 through col. 9, line 2; col. 9, line 32 through col. 10, line 9);

determining a date generation formula associated with the action and a base date used by the date generation formula (col. 8, line 45 through col. 9, line 2; col. 9, line 32 through col. 10, line 9);

applying the date generation formula to the base data to generate the date associated with the action (col. 8, line 45 through col. 9, line 2; col. 9, line 32 through col. 10, line 9); and

including information indicating the action associated with the at least first rule and the date generated by applying the date generation formula in the at least one message (col. 8, line 45 through col. 9, line 2; col. 9, line 32 through col. 10, line 9);

[Claim 9] wherein communicating the at least one message to the first designated client system comprises:

determining one or more users associated with the first intellectual property case from information related to the first intellectual property case (col. 9, line 64 through col. 10, line 2);

from the one or more users, determining a first user who is designated to receive the at least one message generated using the first rule (col. 9, line 64 through col. 10, line 2);

communicating the at least one message to a system used by the first user (col. 9, line 64 through col. 10, line 2);

[Claim 10] wherein communicating the at least one message to the system used by the first user comprises:

sending an electronic mail message to first user, the electronic mail message including the at least one message (col. 9, line 64 through col. 10, line 2).

[Claims 11-20] Claims 11-20 recite limitations already addressed by the rejection of claims 1, 2, 4, 6, 8, and 9 above; therefore, the same rejection applies.

It should be noted that Kamarei uses a processor and memory to perform the recited functionality (col. 5, lines 19-31; col. 5, line 41; col. 6, lines 38-57).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kamarei et al. (U.S. Patent No. 6,859,806), as applied to claim 1 above.

[Claim 3] Kamarei teaches that the plurality of intellectual property cases includes trademark cases (col. 9, lines 6-10), yet Kamarei does not expressly teach that the cases may be copyright cases. However, Official Notice is taken that it is old and well-known in the art of intellectual property to prosecute copyright cases. Kamarei is open to managing various types of transactions with governmental systems (col. 5, lines 26-28) and copyrights are obtained through a government office, such as the U.S.

Copyright Office; therefore, the Examiner submits that it would have been obvious to

one of ordinary skill in the art at the time of Applicant's invention to adapt Kamarei to assist in the management of copyright dockets in order to expand the marketability of Kamarei's invention, thereby increasing the likelihood for profit.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Grundfest (US 2003/0028782) – Discloses a system and method for facilitating initiation and disposition of proceedings online within an access controlled environment.

Porcari (US 2001/0037460) – Discloses a web-based document approval system for creating, reviewing, and approving documents among various parties.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (571) 272-6733. The examiner can normally be reached on Monday-Friday, 10 am - 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Susanna M. Diaz  
Primary Examiner  
Art Unit 3623

January 12, 2006